



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/852,988 | 05/10/2001 | Dong Shin | SBC1022US | 5816 |

7590

07/12/2004

POPOVICH & WILES, P.A.
IDS Center, Suite 1902
80 South 8th Street
Minneapolis, MN 55402

| |
|----------|
| EXAMINER |
|----------|

BLANCO, JAVIER G

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3738

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,988

Applicant(s)

SHIN ET AL.

Examiner

Javier G. Blanco

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-33 and 37-55 is/are pending in the application.
- 4a) Of the above claim(s) 20-24, 41-46, 48 and 53-55 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-33 is/are allowed.
- 6) ☒ Claim(s) 10-15, 19, 37-40, 47, 50 and 51 is/are rejected.
- 7) ☒ Claim(s) 16-18 and 52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Delivery catheter: Species A (conical sheath) and Step of sliding the stent: Species A (stent in a stationary position) in the reply filed on April 20, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 20-24, 41-46, and 48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 20, 2004.

It is noted that claims 53-55 depend on non-elected claim 48. Therefore, claims 53-55 are hereby withdrawn.

Claim Objections

3. Claims 26-28 are objected to because of the following informalities:

a. Regarding claims 26-28, the limitation "wherein the step of disposing" (see line 1) is different from the original language of claims 26-28 (e.g., "wherein the step of providing"). Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3738

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10, 11, 14, 15, 19, 37, 38, 47, 50, and 51 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Igaki (US 5,817,100 A).

As seen in Figures 9-11, Igaki discloses a method of loading a stent (stent 2) on a delivery catheter (catheter 4), the method comprising (i) providing a stent having a length, at least a portion of the length of the stent being in a radially contracted position (compare Figure 9A to Figure 9C; see column 4, lines 9-10 and lines 61-65), providing a conical sheath (an insertion assistant tool such as slider 6) disposed about the distal end of the delivery catheter (see column 5, lines 55-67), and (iii) mounting (= sliding) the stent in the compressed diameter over and past said conical sheath onto the delivery catheter (see column 6, lines 1-17).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12, 13, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igaki (US 5,817,100 A).

Igaki discloses the invention as claimed in claims 10 and 37 except for disclosing the conical sheath as formed from polytetrafluoroethylene. However, the use of PTFE (i.e., Teflon)

Art Unit: 3738

in stent delivery systems is well known in the art. Also, PTFE such as Teflon is known for being flexible and presenting a low coefficient of friction.

It would have been obvious to one having ordinary skill in the art at the time the invention was made have made the conical sheath (= slider 6) of Igaki from PTFE, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

8. Claims 25-33 are allowed.
9. Claims 16 and 52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Dustrude et al. (US 5,911,752 A), Alt (US 6,027,510 A), Limon et al. (US 6,585,747 B1), and Tran et al. (US 6,660,031 B2).
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3738

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. This application contains claims 20-24, 41-46, 48, and 53-55 are drawn to an invention nonelected with traverse in the reply filed on April 20, 2004. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 703-605-4259. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Application/Control Number: 09/852,988

Page 6

Art Unit: 3738

JGB

A stylized handwritten signature consisting of the letters 'J' and 'B' intertwined.

July 7, 2004

A handwritten signature in cursive script, appearing to read 'D. Willse'.

David H. Willse
Primary Examiner